

AMENDMENTS TO THE DRAWINGS

The attached Replacement Sheet and Annotated Sheet include changes to Fig. 5. The Replacement Sheet, which includes Fig. 5, replaces the original sheet including Fig. 5. In Figure 5, previously omitted element 134 has been added.

Attachment: Replacement Sheet and Annotated Sheet

REMARKS/ARGUMENTS

The Office Action was issued on pending claims 1-20. In a previous office action, the Examiner restricted the claims to one of two species of inventions. The Applicants elected the invention of claims 1, 2, 4, 5, 7-13, 15, 16, and 18-20 with traverse on November 1, 2005. Claims 3, 6, 14, and 17 have been withdrawn. In the Office Action, claims 1, 2, 4, 5, 7, 10, and 11 were rejected. Claims 12, 13, 15, 16, and 18-20 were allowed and claims 8 and 9 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant thanks the Examiner for the notice of allowable subject matter.

Claims 4, 5, 10, and 11 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,380,338 ("Christian"). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian in view of U.S. Pat. No. 6,358,199 ("Pauker"). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian in view of U.S. Pat. No. 5,099,577 ("Hutt").

The restriction requirement is respectfully traversed because "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. One of the "two criteria for a proper requirement for restriction between patentably distinct inventions" is that "there must be a serious burden on the

examiner if restriction is not required . . ." MPEP § 803 (emphasis added). While "[f]or purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search . . . [t]hat *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant." MPEP § 803 (emphasis added).

No serious burden is shown that justifies restriction. The Examiner has not shown that Species I and Species II have separate classifications, separate status in the art, or different fields of search. Therefore, the Examiner has not met his *prima facie* burden and the restriction requirement should be withdrawn.

The Examiner objected to Figure 5 of the present application for failing to show element 134 as described in Paragraph 37. Figure 5 has been amended to include element 134 as shown in the attached Replacement Sheet and Annotation Sheet. The Applicant respectfully submits that the amended drawings satisfy 37 C.F.R. 1.84(p)(5).

The Examiner further objected to the specification of the present application for a couple of informalities found in the text of Paragraphs 03 and 34. The Applicant respectfully submits that these paragraphs have been amended to correct the informalities as suggested by the Examiner.

§ 112 Rejection

The Examiner rejected claims 4, 5, 10, and 11 for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention by reciting limitations for "an instrument" or "a component" when such limitations are not

claimed in Claim 1. These claims have been amended so as to no longer recite limitations for an instrument or component. Thus, claims 4, 5, 10, and 11 claim only the subcombination of the attachment mechanism. Therefore, the Applicant respectfully submits that claims 4, 5, 10, and 11 are in condition for allowance.

§ 102(b) Rejection

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by Christian. This rejection is respectfully traversed.

Christian discloses a device for clamping a medical instrument including a pair of gripping arms that are movable between a closed and an open position. The gripping arms are pivotally movable with respect to each other and the device includes means for moving the gripping arms between the open and the closed position. In addition, the gripping arms are rotatably mounted to a support arm that is part of a support apparatus for holding the medical instrument. Christian at Abstract.

Christian fails to teach or suggest "said orientation of each of said engagement pieces to its corresponding leg positioning said engagement pieces to contact said instrument at contact points in order that said component is located at a known and constant distance from said centerline regardless of the diameter of said instrument" as recited in claim 1. Rather, Christian only discloses that each gripping arm 38 "includes a gripping pad 38 rotatably mounted on the gripping arm main body 31." Christian at 3:22-23. Christian does not teach, inherently or explicitly, that gripping pads are oriented to the gripping arm to position the pads to contact an instrument at contact points such that a component attached to the attachment mechanism is located a

known and constant distance from the centerline of the instrument, regardless of the diameter of the instrument. In fact, the holder 24 shown in Fig. 3 of Christian appears to shorten the distance between any component attached to the first arm section 21 and any instrument positioned between the grip pads 38 as the holder 24 is opened wider to accommodate an instrument of a larger diameter.

Because Christian does not teach, nor suggest, orienting each of the engagement pieces to its corresponding leg to position the engagement pieces to contact the instrument at contact points in order that the component is located at a known and constant distance from the centerline regardless of the diameter of the instrument, the Applicant respectfully submits that Christian does not anticipate claim 1 under 102(b), and thus claim 1 should be in condition for allowance.

§ 103(a) Rejection

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian in view of Pauker. This rejection is respectfully traversed.

Pauker discloses a drive mechanism for moving a shaft or rod along its central axis that utilizes a flexible eversion tube surrounding a portion of, and slidingly engaged to, the outer surface of the shaft or rod. The drive mechanism uses at least one wheel group having two or more drive wheels that are coplanar with each other and, along the shaft's axis of movement, are aligned with each other and spaced apart. The drive wheels are in compressive contact with a central portion of the flexible eversion tube. The at least one wheel group is supported and located around the central portion by a sleeve that surrounds the central portion of the eversion tube. The sleeve contains slits

that permit the individual wheels to contact the central portion of the tube and a casing having two pivotally connected halves that when clamped together, seal the wheel groups and sleeve within its cavity and enable a drive source to drive the wheels.

Pauker at Abstract.

The Applicant submits that Christian, alone or in combination with Pauker, does not teach, nor suggest, the invention of claim 2. First, neither Christian (as discussed above), nor Pauker, teaches or suggests “said orientation of each of said engagement pieces to its corresponding leg positioning said engagement pieces to contact said instrument at contact points in order that said component is located at a known and constant distance from said centerline regardless of the diameter of said instrument” as recited in claim 2. Pauker is not even related to an attachment mechanism and certainly does not teach or suggest engagement pieces oriented on legs to contact an instrument at contact points in order that a component is located a known and constant distance from the centerline regardless of the diameter of the instrument.

Furthermore, though Pauker does disclose “drive wheels” for feeding an endoscope shaft, Pauker certainly does not teach, nor suggest, that the drive wheels “engage said instrument at contact points that **maintain said component at said distance from said centerline of said instrument**” as recited in claim 2. In fact, Pauker actually teaches away from maintaining a component at a distance from a centerline of an instrument by teaching that the drive wheels are used to drive the shaft. See Pauker at Abstract; 6:2-5. Likewise, as the Examiner acknowledges, Christian does not teach, nor suggest, “rollers engage said instrument at contact points that

maintain said component at said distance from said centerline of said instrument” as recited in claim 2. Therefore, the combination of Christian and Pauker does not teach, nor suggest, all the limitations of claim 2, and the Applicant respectfully submits that claim 2 is in condition for allowance.

Additionally, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine reference teachings. However, no reason has been shown why it would be obvious to selectively combine the laparoscope holder of Christian with the drive mechanism for moving a shaft of Pauker to arrive at the claimed invention of claim 2. The Examiner asserts that Pauker is in an analogous field of art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” M.P.E.P. at 2141.01(a). Pauker is related to a drive mechanism for moving a shaft. Pauker at Abstract. Claim 2 is directed to an attachment mechanism for attaching a component to an instrument. Thus, Pauker and the invention of claim 2 are clearly in different fields of endeavor. Furthermore, Pauker is not reasonably pertinent to the problem of attaching an instrument to a component as is the invention of claim 2. Therefore, Pauker is not analogous to the field of endeavor of claim 2.

Additionally, even if the Pauker reference is analogous to the present invention of claim 2, it still would not have been obvious to combine Christian with Pauker to arrive at the invention of claim 2. Pauker discloses **drive wheels for moving a shaft** while Christian discloses a laparoscope holder for **clamping** about a medical instrument.

There simply would have been no motivation for a person of skill in the art to combine moving drive wheels with a clamp to secure an instrument. Therefore, the Applicant respectfully submits that there would be no motivation to combine Christian with Pauker to arrive at the claimed invention of claim 2. For each of these reasons, the Applicant respectfully submits that claim 2 is non-obvious in view of these references.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian in view of Hutt. This rejection is respectfully traversed.

Hutt discloses a tube cutter consisting of two frame portions or jaws, being pivoted to one another at their end portions, and further interconnected at their intermediate portions by a large bolt through which the jaws move relative to one another about their common pivot. The free end of one jaw carries anvil rollers, and the other jaw free end carries a discoid knife, the anvil roller and knife cooperating in tangentially cutting a tube extending transversely between the free ends. The knife is freely carried by a jaw axle, which is itself freely releasably engaged through the jaw. A spring-loaded band within the knife containing jaw casing frictionally yet releasably locks the knife axle, and thus the knife, in position, by engaging a smaller portion of the knife axle. Hutt at Abstract.

The Applicant submits that Christian, alone or in combination with Hutt, does not teach, nor suggest, the invention of claim 7. First, neither Christian (as discussed above), nor Hutt, teaches or suggests "said orientation of each of said engagement pieces to its corresponding leg positioning said engagement pieces to contact said instrument at contact points in order that said component is located at a known and

constant distance from said centerline regardless of the diameter of said instrument" as recited in claim 7. Hutt is not even related to an attachment mechanism and certainly does not teach or suggest engagement pieces oriented on legs to contact an instrument at contact points in order that a component is located a known and constant distance from the centerline regardless of the diameter of the instrument.

Additionally, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine reference teachings. However, no reason has been shown why it would be obvious to selectively combine the laparoscope holder of Christian with the **tube cutter** of Hutt to arrive at the claimed invention of claim 7. The Examiner asserts that Hutt is in an analogous field of art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." M.P.E.P. at 2141.01(a). Hutt is related to a knife axle for use with a **tube cutter**. Hutt at Abstract. Claim 7 is directed to an attachment mechanism for attaching a component to an instrument. Thus, Hutt and the invention of claim 7 are clearly in different fields of endeavor. Furthermore, Hutt is not reasonably pertinent to the problem of attaching an instrument to a component as is the invention of claim 7. Therefore, Pauker is not analogous to the field of endeavor of claim 7.

Additionally, even if the Hutt reference is analogous to the present invention of claim 7, it still would not have been obvious to combine Christian with Hutt to arrive at the invention of claim 7. Pauker discloses a releasable knife axle for use with a tube

Response to Office Action

Serial No. 10/699,960

Page 18 of 18

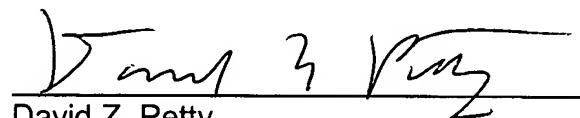
cutter while Christian discloses a laparoscope holder for clamping about a medical instrument. There simply would have been no motivation for a person of skill in the art to combine a releasable knife axle tube cutter with a laparoscope holder. Therefore, the Applicant respectfully submits that there would be no motivation to combine Christian with Hutt to arrive at the claimed invention of claim 7. For each of these reasons, the Applicant respectfully submits that claim 7 is non-obvious in view of these references.

Conclusion

In view of the above, the pending claims are believed to be in condition for allowance. The Examiner is invited to telephone the Applicant's undersigned attorney at (312) 775-8000 if any unresolved matters remain.

Please charge any additional fees due in connection with this submission and credit any overpayment to Deposit Account No. 13-0017.

Respectfully submitted,



David Z. Petty
Reg. No. 52,119
Attorney for Applicant

McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

5/6

FIG. 5

